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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,033	06/28/2001	Kenneth McClure	873.0011.USU	5495

29683 7590 04/22/2004

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EXAMINER

GELIN, JEAN ALLAND

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/894,033

Applicant(s)

MCCLURE, KENNETH

Examiner

Jean A Gelin

Art Unit

2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Raith (US 6,711,408).

Regarding claims 1, 4, Raith teaches a method for operating a wireless communication system, comprising: determining, at a network operator, a location of a mobile station (col. 3, line 67 to col. 4, line 4); determining if the location of the mobile station indicates that the mobile station may gain access to another allowed network operator (i.e., based on location more than one channels are selected, col. 4, lines 1-29); and if so, transmitting a message to the mobile station for assisting the mobile station in gaining access to the other, allowed network operator (i.e., sending channels to the mobile for handoff, col. 4, lines 1-29, and instructs the mobile to change to new channel, col. 7, lines 10-40).

3. Claim 7 rejected under 35 U.S.C. 102(e) as being anticipated by Dorenbosch (US 6,198,406).

Regarding claim 7, Dorenbosch teaches a mobile station (portable subscriber unit 222) comprising a RF transceiver (308, 309), a data processor (310) and a memory (312), said data processor being responsive to a message received through said RF transceiver from a network operator that is currently serving said mobile station for storing information into said memory (i.e., processing scan lists received over the air, col. 9, lines 46-58), said data processor being responsive to said stored information for one of inhibiting background scanning for another, network operator, or for attempting to access another network operator in accordance with the stored information (col. 10, lines 43-54).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 3, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raith (US 6,711,408) in view of Otting et al. (US 6,477,372).

Regarding claims 2, 5, Raith teaches all the limitations above except transmitting a message to the mobile station for inhibiting background scanning by the mobile station.

However, the preceding limitation is known in the art of communications. Otting teaches a method to perform background scans wherein the base station decides when

Art Unit: 2681

to search for an alternate technology, and the network gives the radio telephone an indication of whether alternate network is allowed (col. 2, line 66 to col. 3, line 23); the network can disable alternate technology scans (col. 4, lines 9-16). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the technique of Otting within the system of Raith in order that the radio telephone can skip the background scans and limit locations in which alternate band scan is performed.

Regarding claims 3, 6, Raith teaches all the limitations above except wherein the message comprises information descriptive of a frequency on which the mobile station may receive a transmission from the other, allowed network operator.

However, the preceding limitation is known in the art of communications. Otting teaches a method to perform background scans wherein the network gives the radio telephone an indication of whether alternate technology service searches are allowed, by sending bits in attached message (col. 3, lines 1-23). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the technique of Otting within the system of Raith in order that the radio telephone can skip the background scans and limit locations in which alternate band scan is performed.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dorenbosch (US 6,198,406) in view of Otting et al. (US 6,477,372).

Regarding claim 8, Dorenbosch teaches all the limitations above except wherein the message comprises information descriptive of a frequency on which the mobile station may receive a transmission from the other, allowed network operator.

However, the preceding limitation is known in the art of communications. Otting teaches a method to perform background scans wherein the network gives the radio telephone an indication of whether alternate technology service searches are allowed, by sending bits in attached message (col. 3, lines 1-23). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to implement the technique of Otting within the system of Dorenbosch in order that the radio telephone can skip the background scans to save power whenever it is known a priori that while monitoring certain systems the radio telephone could never find a more appropriate system.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Barnett et al. (US 5,422,933) teaches requesting the mobile station to stop scanning.

Lee et al. (US 5,940,762) teaches inter-system calling supporting inter-system soft-handoff.

Palamara (US 6,654,362) teaches use of location in handoff in wireless communication systems.

Papasakellariou (US 6,526,090).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean A Gelin whose telephone number is (703) 305-4847. The examiner can normally be reached on 9:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Erika A Gary can be reached on (703) 308-0123. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JEAN GELIN
PATENT EXAMINER

JGelin
April 8, 2004

Jean Allard Gelin